



Paper No. 16

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OFFICE OF PETITIONS

ON PETITION

In re Application of:
McCarthy
Application No.: 08/842,898
Filed: April 17, 1997
Attorney Docket No. MEI-014CP
For: NOVEL CRSP-1 COMPOSITIONS AND
THERAPEUTIC AND DIAGNOSTIC USES
THEREFOR

This is a decision on the petition under 37 CFR 1.182 filed February 27, 2004, requesting entry of an amendment to the specification to insert a reference to an earlier-filed application (namely, Application No. 08/843,704) pursuant to the provisions of 35 USC 120.

The petition under 37 CFR 1.182 is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.182." Petitioner is advised that this is not a final agency decision.

The file record discloses that this application was co-pending with the earlier-filed Application No. 08/843,704, but became abandoned before a specific reference to the earlier-filed application was made in this application. Petitioner requests that this abandoned application be amended by inserting a reference to the above-noted, earlier-filed application.

The instant petition is accompanied by an amendment to include a reference to the prior-filed application in the first line of the specification following the title of the invention. 35 USC 120 permits entry of a subsequent amendment to an abandoned application in applications filed prior to November 29, 2000 to include the benefit of an earlier filing date for purposes other than prosecution. See Sampson v. Commissioner of Patents and Trademarks, 195 USPQ 136(DC DC 1976).

A reference to add the above-noted, prior-filed application on page one following the first sentence of the specification has been included in an amendment filed on February 27, 2004. However, the amendment is not acceptable as drafted since it improperly incorporates by reference the prior application. Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d. 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew a distinction between a permissible 35 U.S.C. § 120 statement and the impermissible introduction of new matter by way of incorporation by reference in a 35 U.S.C. § 120 statement. The court specifically stated:

Section 120 merely provides a mechanism whereby an application becomes entitled to benefit of the filing date of an earlier application disclosing the same subject matter. Common subject matter must be disclosed, in both

applications, either specifically or by an express incorporation-by-reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. In re deSeversky, supra at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore, "limit" the absolute and express prohibition against new matter contained in section 251.

Accordingly, before the petition under 37 CFR 1.182 can be granted, a substitute amendment deleting the incorporation by reference statement is required.

The correspondence address listed on the petition is not the correspondence address of record. The application file does not indicate a power of attorney for the attorney who signed the petition has been filed in this case. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.


Further correspondence with respect to this matter should be addressed as follows:

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